

## **REMARKS**

Reconsideration of the application, as amended, is respectfully requested.

### **I. STATUS OF CLAIMS**

Claims 2, 24, and 30 are pending in this application. Claims, 2, 24 and 30 have been amended to provide proper antecedent basis for the expression “said security alarm system” in each of these claims. In addition, claims 24 and 30 were amended to correct certain informalities in these claims. It is respectfully submitted that no new matter has been added by virtue of this amendment. Support for amended claims 2, 24 and 30 may be found throughout the specification as originally filed.

### **II. CLAIM OBJECTIONS**

Claims 24 and 30 were objected to as containing certain informalities.

In response, the following amendments were made to the above claims in accordance with the Examiner’s suggestions. First, line 1 of claim 24 has been amended by replacing the term “as” with the term ‘a’. Line 3 of claim 24 has been amended by replacing the term “Said” with “said”. In addition, line 1 of claim 30 has been amended by replacing “aa” with “a”. Further, line 1 of claim 30 has been amended by replacing the term “alarm” with ‘alarm’.

Due to the actions taken, it is respectfully asserted that the above objections have been obviated. Accordingly, removal of these objections is respectfully requested.

### **III. 35 U.S.C. 112, Second Paragraph Rejections**

(I) Claims 2, 24 and 30 were rejected on the grounds that there was a lack of antecedent basis for the limitation “said security alarm system” recited in each of these claims.

In response, line 1 of claims 2, 24 and 30 have been amended herewith to insert to the term “system” after the term “alarm” for providing proper antecedent basis in each of these claims.

(ii) Claims 2, 24 and 30 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite on the grounds that the limitation of “In combination, a toy and a security alarm, comprising said security alarm system for toy comprising a controller...unarmed states” is confusing.

In response, as noted above, line 1 of claims 2, 24 and 30 have been amended by inserting the term “system” after the term “alarm” such that it is now absolutely clear that these claims each recite the combination of a toy and a security alarm system.

Due to the actions taken, it is respectfully asserted that the above rejections have been obviated. Accordingly, removal of these rejections is respectfully requested.

### **IV. REJECTIONS UNDER 35 U.S.C. § 103(a)**

Claims 2, 24 and 30 were rejected under 35 U.S.C. 103 (a) over U.S. Patent No. 4,754,255 to Sanders et al. (“the Sanders patent”) in view of the Applicants admitted prior art on page 1 of the specification.

In response, Applicants respectfully submit that obviousness rejections to claims

2, 24 and 30 should be removed because a prima facie case of obviousness has not been established. The initial burden of establishing a prima facie case of obviousness is on the Examiner. (See MPEP 2142) One of the elements required in order to establish a prima facie case of obvious is a showing of a motivation or suggestion in the prior art to make the proposed combination or modification. (See MPEP 2143). At the very least, the Examiner has failed to show a motivation provided in the prior art to one skilled in the art to make the above proposed combination in an attempt to arrive at the presently claimed invention.

As conceded by the Examiner, the Sanders reference fails to teach the use of its security alarm system with a toy as required by claims 2, 24 and 30 of the presently claimed invention. The background section of the Applicants specification was cited in an attempt to cure these deficiencies of the Sanders patent.

It is respectfully submitted that there is no motivation provided in the prior art to one skilled in the art to make the above proposed combination because there is nothing in the record or in the cited prior art which teaches or suggests providing security alarms in toy devices. As mentioned, the Sanders patent relates entirely to a vehicle control and/or anti-theft system for real-life automobiles. There is no teaching or suggestion in Sanders, however, of replicating any of its parts for use in a toy. Moreover, the cited background portions of the present specification likewise fail to teach or suggest replicating the features of a security alarm device from a real-life automobile and incorporating these alarm features into a toy in an attempt to arrive at the presently claimed invention. These cited portions of the specification essentially state only in general terms that toy designers seek to provide realism in toy vehicles by replicating, sound, function and appearance of real life versions, but fail to provide the specifics of these real life features and also make no mention of replicating security alarm devices. Rather, the only mention in the record of replicating real-life security alarm devices for use with toys comes from the areas of the present application which describe the presently claimed invention, but not from the

is not your standard security alarm device but rather is a more complex type of alarm. The fact that the Sanders alarm is more complex than standard alarms makes it an unlikely choice for use in the toy vehicle industry, which targets mostly children as its intended consumers. In sum, there is clearly insufficient evidence set forth in the record and the cited prior art for establishing the desirability to one skilled in the art of toy design art to modify the specific type of alarm system described in Sanders for use with a toy

Therefore, for the above reasons, the Examiner has failed to meet the required initial burden of establishing a prima facie case of obvious by failing to establish the requisite motivation in art to one of ordinary skill in the art to make the above proposed combination

In addition to the above arguments, an evidentiary affidavit pursuant to 37 C.F.R. 1.132 is also being submitted herewith to overcome the above obvious rejection by establishing the commercial success of the toy/alarm system combination recited in claims 2, 24 and 30 of the presently claimed invention and also establishing that this commercial success was due to the features recited in these claims. Demonstrating the commercial success of a product of a claimed invention is a very strong factor weighing against the finding of obviousness of the invention. In fact, a proper showing of commercial success of a claimed invention alone is sufficient in overcoming an obvious rejection under 35 U.S.C. 103(a). **(See MPEP 2144.08).**

It is respectfully submitted that based upon the above arguments and evidentiary submission establishing the commercial success of the presently claimed invention, the above obviousness rejection to claims 2, 24 and 30 has been overcome and should thus be removed.

cited art (including the cited background portions of the specification). It is well known under the U.S. patents laws that the teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure which describes the claimed invention. ( See **In re Vaeck**, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Even assuming arguendo that it is known in the art to replicate real life security alarm devices for use in toys, the Examiner has still failed to adduce sufficient evidence in the record for establishing that one skilled in the art would have chosen to modify the specific alarm system described in Sanders for use with a toy, in an attempt to arrive at the presently claimed invention. In particular, the fact that a certain feature or type of feature is known in the automobile industry, does not necessarily mean that one skilled in the toy design industry would choose to replicate this feature or type of feature for use with a toy because it is simply not always desirable and/or practical for a toy designer to do so. The toy industry and the automobile industry are very distinct industries from one another with very differing concerns. The automobile industry is more concerned with the performance and safety of the vehicle, whereas the toy industry is more concerned with the attractiveness and fun value which will be provided by the toy. Thus, just because a feature is known in the automobile industry does not necessarily make this particular feature or type of feature a candidate for use in the distinct toy industry.

For example, if a toy designer believed that a certain known automobile feature or type of feature would not be of interest to or be too sophisticated for a particular intended targeted group of consumers, e.g. children, the toy designer would clearly not replicate or develop this feature or type of feature for use with a toy. Maybe at best it could be argued that one skilled in the toy design art would seek to possibly replicate a standard/basic type of alarm system in order to impart a more realistic effect to the toy , since many of these are in real-life automobiles today and probably would not be considered too difficult for children to operate. However, the alarm described in Sanders

## V. CONCLUSION

In view of the actions taken and arguments made it is believed that all pending claims as currently presented are now in condition for allowance. A Notice of Allowance is respectfully requested.

According to currently recommended Patent Office policy, the Examiner is requested to contact the undersigned at the telephone number provided below in the event that a telephone interview will advance the prosecution of this application. An early and favorable action is earnestly solicited.

In addition, a petition for a one-month extension of time and a check in the amount of \$120.00 covering the one month extension fee are also enclosed herewith extending the time to respond until March 5, 2005 (Saturday). No additional fees are believed to be due with this amendment. However, if any fees are due, the Commissioner of Patents is authorized to charge my deposit no. 11-1152.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Richard B. Klar', is written over a horizontal line.

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